

Remarks

For the Claims:

Applicant submitted claims 8-14 and 16 in connection with a Request for Continued Examination, dated 16 June 2006. A non-final Office Action, mailed 14 September 2006, rejected claims 8-14 and 16. An Amendment, dated 27 November 2006, amended claim 8 and retained claims 9-14 and 16 as previously presented. A Final Office Action, responding to the 27 November 2006 Amendment, maintained the rejection of claims 8-14 and 16. In an Amendment, dated 18 June 2007, accompanying a second Request for Continued Examination, dated 18 June 2007, claims 8, 10, 12, 13, and 16 were amended, claims 9 and 14 were retained as previously presented, and claim 11 was canceled. A non-final Office Action, responding to the 18 June 2007 Amendment rejected all claims, i.e., claims 8-10, 12-14, and 16. In an Amendment, dated 10 December 2007, claims 8 and 12 were amended and claims 9, 10, 13, 14, and 16 were retained as previously presented. This non-final Office Action, responding to the 10 December 2007 Amendment, again rejects all claims, i.e., claims 8-10, 12-14, and 16. Applicant retains claims 8-10, 12-14, and 16 as previously submitted. Applicant respectfully requests reconsideration in view of the following remarks.

This Non-Final Office Action acknowledges that Applicant's arguments, with respect to the rejection(s) of claim(s) 8-10, 12-14, and 16 under Lending Tree, were fully considered and were persuasive. As such, the rejection was withdrawn. However, this Non-Final Office Action now asserts new grounds of rejection against all claims.

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This Office Action rejects claims 8, 9, and 14 under 35 U.S.C. 103(a) as being unpatentable over Ingram et al., U.S. Publication No. 2002/0077967 (hereinafter Ingram), in view of Whitney, U.S. Publication No. 2002/0111901, in further view of Florance et al., U.S. Patent No. 6,871,140 (hereinafter Florance). Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ingram in view of Whitney, in further view of Florance, and further in view of Casper, U.S. Publication No. 2002/0069151. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ingram in view of Whitney, in further view of Florance, and further in view of Project Management. Claims 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingram in view of Whitney, in further view of Florance, and further in view of Pacifica.

The following Declarations under 37 C.F.R. 1.131 accompany this Response:

- 1) Declaration of Patrick S. Cunningham including Exhibits A-P; and
- 2) Declaration of Jill R. Cunningham.

All claims are rejected as being unpatentable over a combination of Ingram and Whitney, or over a combination of Ingram and Whitney in combination with other prior art under 35 U.S.C. §103(a). In addition, claim 10 is rejected as being unpatentable over Ingram, Whitney, Casper, and Florance.

Ingram was filed on 12 October 2001 as a non-provisional application of a provisional application, Application No. 60/240,172, filed on 13 October 2000. The present application was filed on 5 February 2001. Accordingly, the Ingram publication has an effective filing date less than one year prior to the filing date of the present application.

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In addition, Whitney was filed on 24 January 2002 as a non-provisional application of a provisional application, Application No. 60/263,925, filed on 24 January 2001. Since the present application was filed on 5 February 2001, the Whitney publication has an effective filing date less than one year prior to the filing date of the present application. Casper was filed on 1 December 2000, and is not based upon an earlier filed application. Therefore, the Casper publication also has a filing date less than one year prior to the filing date of the present application.

This Response is accompanied by Declarations under 37 C.F.R. 1.131 by Patrick S. Cunningham and Jill R. Cunningham which overcome the Ingram, Whitney, and Casper references. This Rule 1.131 showing was not presented earlier in connection with the Ingram and Casper references because claim modifications and arguments presented in the earlier Amendments overcame rejections set forth in prior Office Action. In addition, this Rule 1.131 showing was not presented earlier in connection with the Whitney reference because the Whitney publication was first cited in this Non-Final Office Action, mailed 20 March 2008. The below presented material sets forth the following:

- A) none of the Ingram, Whitney, and Casper references claims the same patentable invention as the present application;
- B) the Ingram, Whitney, and Casper references disclose features which may be relevant to the present invention;
- C) the present invention was conceived prior to the effective filing dates of the Ingram, Whitney, and Casper references;
- D) the present invention was constructively reduced to practice after the effective filing dates of the Ingram, Whitney, and Casper references;

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- E) the reduction to practice of the present invention is coupled with due diligence from a date prior to the effective filing dates of the Ingram, Whitney, and Casper references until the subsequent constructive reduction to practice; and
- F) the antedating of the Ingram, Whitney, and Casper references overcomes all rejections, making claims 8-10, 12-14, and 16 allowable.

(A) "But Does Not Claim" Element

A Rule 1.131 "showing" is available when the reference is prior art under 35 U.S.C. §102(a) or §102(e) and substantially shows or describes but does not claim the same patentable invention. These elements are readily met here. Each of the Ingram, Whitney, and Casper references is a §102(e) reference. MPEP 715.05 states that "if the [prior art reference] patent is claiming the same invention as the application, this fact should be noted in the Office action." Nothing in the Non-Final Office Action suggests that the Ingram, Whitney, and Casper references are claiming the same invention as the present application or that they are §102(g) references. Indeed, the Non-Final Office Action acknowledges the opposite. That is, since all claims are rejected in view of at least a combination of the Ingram and Whitney references in accordance with the provisions of 37 U.S.C. §103, none of the Ingram, Whitney, and Casper references can claim the same invention as the present application.

The Non-Final Office Action properly reflects that none of the Ingram, Whitney, and Casper references claim the same invention as the present invention because the Office Action acknowledges that none of these references taken individually teach all of the features claimed in the above-identified application. The legal standard to use in considering the "does not claim" phrase of 37 C.F.R. 1.131 was set forth in *In re Eickmeyer*, 202 U.S.P.Q. 655 661 (C.C.P.A. 1979) as follows:

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the phrase 'does not claim the rejected invention' should be construed favorably to an applicant, if possible, so that unless the applicant is clearly claiming the same invention as the U.S. patent reference, he will not lose his rights under Rule 131.

Accordingly, none of the Ingram, Whitney, and Casper references claims the same patentable invention as the present application.

(B) Ingram, Whitney, and Casper Disclose Relevant Features

The focus of a Rule 1.131 showing is on establishing possession of "the invention" prior to the reference and not on the claims of the application. As stated in In re Clarke, 148 USPQ 665 670 (C.C.P.A. 1966):

...Claims do define "the invention," but in a given case may be of varying scope while still defining the same invention; what is "the invention" should not be confused with the scope thereof in this area of the law dealing with establishing *prima facie* a case of prior inventorship.

It follows from the above views that antedating affidavits must contain facts showing a completion of "the invention" commensurate with the extent the invention is shown in the reference [emphasis supplied], whether or not it be a showing of the identical disclosure of the reference. In our view, where it can be concluded that facts, offered in a Rule 131 affidavit in support of a general allegation of conception and reduction to practice of the invention, would persuade one of ordinary skill in the art to a reasonable certainty that the applicant possessed *so much of the invention as to encompass the reference disclosure*, then that showing should be accepted as establishing *prima facie* a case of inventorship prior to the reference, sufficient for the purpose of overcoming the reference in an *ex parte* case.

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Accordingly, Applicant's Rule 131 showing, as set forth below, relates to a completion of "the invention" at least commensurate with the extent the invention is shown in the Ingram, Whitney, and Casper references.

The Ingram reference discloses a method and system for automatically administering a loan via a web-based communications network. A builder goes to its respective website and requests to apply for a loan (page 4, paragraph 48). The builder submits a detailed description of the project plan and a lender determines approval of a construction loan. Once the builder is approved for the loan, the builder can submit a draw request electronically so that monetary funds can be transferred from the lender to the builder (page 5, paragraph 49).

Accordingly, Ingram discloses features which may be relevant to the present invention. Features include the use of a website to request to apply for a loan, the submission electronically of builder information, entering and submitting information related to a construction project, and following approval of the construction loan, submitting draw requests and transferring monetary funds.

The Whitney reference discloses a loan servicing system in which a loan servicing company receives and/or facilitates the submission of loan applications for credit from the client. Upon receipt of the loan application for credit, the loan servicing company files the application for credit with any one of a plurality of banks or lending institutions (page 3, paragraph 25). The loan servicing company can select the lending institution from the plurality of lending institutions (page 3, paragraph 25). The lending institution reviews information contained in the application for credit and decides whether to approve or deny the credit application (page 3, paragraph 26).

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Accordingly, Whitney discloses a feature which may be relevant to the present invention. This feature is the selection of a lending institution from the plurality of lending institutions.

The Casper reference discloses a buyer pre-approval process in which a lender analyzes buyer information and upon approval provides the buyer with a buyer password so that the buyer may bid on properties listed on a web site (page 2, paragraph 20).

Accordingly Casper discloses a feature which may be relevant to the present invention. This feature is the provision to the buyer of a buyer password.

(C) Conception Of The Invention

The Patrick S. Cunningham Declaration (referred to herein as P. Cunningham Declaration) and the Jill R. Cunningham Declaration (referred to herein as J. Cunningham Declaration) establish that "the invention" as it relates to the Ingram, Casper, and Whitney references was known prior to the Ingram effective filing date of 12 October 2001. In particular, the substance of the invention had been communicated from Patrick Cunningham to Jill Cunningham (see P. Cunningham and J. Cunningham Declarations). In addition, prior to 12 October 2001, Patrick Cunningham committed time and energy into developing a software outline for "the invention" (See P. Cunningham Declaration, Exhibit A).

The P. Cunningham Declaration and the J. Cunningham Declaration provide evidence that the invention claimed in the present application was conceived before the effective filing dates of the Ingram, Casper, and Whitney references.

Development of a detailed document describing and further refining "the invention" (see P. Cunningham Declaration, Exhibit P) provides additional evidence that the invention claimed in the present application was conceived before the effective filing date of the Whitney reference.

(D) Reduction To Practice

The features of the present invention were constructively reduced to practice when the patent application was filed on 5 February 2008.

(E) Due Diligence

The P. Cunningham Declaration establishes due diligence from the date of conception on or about 12 June 2000 through a constructive reduction to practice, i.e., the filing of the above-identified patent application on 5 February 2001. In addition to activities related to preparing and filing the patent application, Applicant's activities related to an actual reduction to practice should also be considered.

Activities Related to a Constructive Reduction to Practice:

Following conception of "the invention," between 20 November 2000 and 30 November 2000, Patrick Cunningham contacted his attorney to ask his recommendation for a patent attorney to prepare and file a patent application. On 30 November 2000, he received a fax from his attorney recommending a patent attorney (see P. Cunningham Declaration, Exhibit D) in preparation for a constructive reduction to practice of the invention.

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On 4 December 2000, Patrick Cunningham met with a patent agent from the Law Offices of Louis J. Hoffman and disclosed his invention in detail to the patent agent. On 11 December 2000, Patrick Cunningham paid a retainer to the Law Offices of Louis J. Hoffman for services related to preparing and filing a patent application (see P. Cunningham Declaration). When no response was made by the patent agent or another representative from the Law Offices of Louis J. Hoffman, Patrick Cunningham diligently sent a fax on 15 December 2000 requesting a response. Unfortunately, on 3 January 2001, Patrick Cunningham received a refund of his retainer (see P. Cunningham Declaration and Exhibit H. His impression was that they were unwilling or unable to prepare a patent application for the invention.

Consequently, Patrick Cunningham was now compelled to seek out another patent attorney. Patrick Cunningham contacted and met with another patent attorney on 8 January 2001 (see P. Cunningham Declaration). At that time, he paid a retainer to Harry M. Weiss and Associates (a.k.a. "Weiss and Moy, P.C.") for fees/services related to preparing and filing a patent application (see P. Cunningham Declaration, Exhibit I) in order to constructively reduce the invention to practice. Meanwhile, Patrick Cunningham developed a detailed document describing and further refining "the invention" (see P. Cunningham Declaration, Exhibit P). This document was provided to Jeffrey Moy of Weiss and Moy, P.C. so that Mr. Moy would have sufficient information regarding the invention in order to prepare the above-identified application.

It should be noted that Patrick Cunningham first met with Jeffrey Moy on 8 January 2001 and the application was filed on 5 February 2001. Thus, a span of time from an initial meeting until the filing of a patent application was a mere twenty-eight days. This short span of time indicates that the phases of preparation, filing, and review of the patent application were

performed with reasonable diligence by the patent attorney, Jeffrey Moy, and by Patrick Cunningham.

Moreover, the subject matter of the claims is properly supported by the written specification in the application. By way of example, independent claim 8 is reprinted below with passages cited from Applicant's specification supporting the subject matter of the claim.

Claim 8. A method for the application and payment of construction loans between lenders and builders comprising:

establishing a loan website on a host server (**page 6, lines 6-9, Figure 1**);

selecting from the loan website a desired lender from a list of the lenders, the selecting operation being performed by one of the builders (**page 6, lines 15-18**);

in response to selection of the desired lender from the loan website, automatically transferring the builder to a lender website of the desired lender via a link on the loan website to the lender website, the lender website containing a credit application form for the lender (**page 6, lines 19-24**);

submitting electronically, by the one builder, builder information pertinent to the one builder using the credit application form (**page 6, line 24, through page 7, line 11**), the desired lender determining approval for the one builder to obtain credit from the desired lender in response to the builder information (**page 7, lines 12-14**);

upon determination of approval, entering and submitting information related to a construction project

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from the one builder to the desired lender via the loan website (page 7, line 18, through page 10, line 7);

determining approval of a construction loan for the construction project upon receipt of the information, the determining operation being performed by the desired lender (page 8, lines 8-9);

following approval of the construction loan, submitting a request for payment from the one builder to the desired lender via the loan website (page 11, line 20, through page 12, line 16); and

transferring monetary funds from the desired lender to the builder after the request for payment is approved (page 12, line 22, through page 13, line 1).

Activities Related to an Actual Reduction to Practice:

Following conception of the invention, Patrick Cunningham researched options for an actual reduction to practice of the invention, and located a company, Cybercilium, Inc., who would do the programming necessary to develop the product (See P. Cunningham Declaration). In late October 2000, Patrick Cunningham had completed his research and was ready to invest into the start up of developing the payment software application (see P. Cunningham Declaration). However, since Patrick Cunningham was relatively unfamiliar with privacy concerns regarding the invention, he researched the Internet to learn about nondisclosure agreements (see P. Cunningham Declaration, Exhibit B) and contacted his attorney to ask for his review of a sample Confidentiality and Non-Circumvent Agreement (see P. Cunningham Declaration, Exhibit C) in preparation for an actual reduction to practice of the invention.

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Patrick Cunningham continued development of the nondisclosure agreement which was eventually signed by an Oracle database developer, namely Cybercilium, Inc. (see P. Cunningham Declaration, Exhibits E, F, J, K) in order to initiate the actual reduction to practice. Additionally, concurrent with the above activities, Patrick Cunningham filed for and registered a domain name on 11 January 2001 for the loan website of the invention (see P. Cunningham Declaration, Exhibits L, M). Still further, Patrick Cunningham had a meeting with representatives of Cybercilium on 18 January 2001 to discuss the invention in detail and describe the services that they could provide. In follow up to that meeting, Cybercilium provided a proposal for development of a Contractor Payment Portal using Oracle technology (see P. Cunningham Declaration, Exhibit O).

The above information establishes a series of activities that are not directly related to the preparation and filing of the patent application, but should nevertheless be considered. These activities should be considered because they show that the inventor made a conscious effort to reduce the invention to practice. Furthermore, these efforts occurred concurrent with the efforts associated with the constructive reduction to practice.

(F) Antedating Ingram, Casper, and Whitney Overcomes All Rejections

For reasons set forth above none of the Ingram, Casper, and Whitney references claim the same invention as claimed in the present application. Applicant's invention was conceived before the effective dates of Ingram, Casper, and Whitney and was diligently pursued until at least constructively reduced to practice. Accordingly, Applicant's invention antedates the

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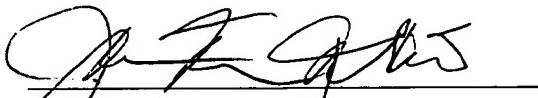
Ingram, Casper, and Whitney references, causing each of the Ingram, Casper, and Whitney references to be removed from consideration in determining patentability.

This non-Final Office Action applied Ingram and Whitney as the primary references against all claims. By removing Ingram and Whitney, the rejections to all claims under the provisions of 35 U.S.C. §103(a) are overcome, making claims 8-10, 12-14, and 16 allowable. Furthermore, by removing Ingram, Whitney, and Casper, the rejection to claim 10 under the provisions of 35 U.S.C. §103(a) is overcome.

Accordingly, claims 8-10, 12-14, and 16 remain in the application as previously submitted. This Response is accompanied by declarations which make a Rule 1.131 showing to antedate the Ingram, Casper, and Whitney references. By removing the Ingram, Casper, and Whitney references, all rejections have been overcome and claims 8-10, 12-14, and 16 are allowable.

Applicant believes that the foregoing remarks are fully responsive to the rejections recited in the 20 March 2008 Office Action and that the present application is now in a condition for allowance. Accordingly, reconsideration of the present application is respectfully requested.

Respectfully submitted,



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